

Docket No.: 2038-282

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	<u>EXPEDITED PROCEDURE</u>
Masashi NAKASHITA	:	<u>RESPONSE UNDER 37 CFR 1.116</u>
	:	
U.S. Patent Application No. 10/024,544	:	Group Art Unit: 3761
	:	Confirmation No. 3584
Filed: December 21, 2001	:	Examiner: K. Reichle
For: BODY FLUID ABSORBENT WEARING ARTICLE		

PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 CFR 1.144

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

Applicant hereby petitions to have the Restriction Requirement between Inventions I and II reconsidered.

Applicant further petitions to have the finality of the Office Action mailed August 23, 2004 withdrawn.

The following reasons are offered for this request:

1. By a Restriction Requirement mailed April 19, 2004, Examiner Reichle required restriction to one of the following inventions:

Invention I: Claims 1-5, drawn to a body fluid absorbent wearing article, classified in class 604, subclass 380.

Invention II: Claims 6-15, drawn to a body fluid absorbent wearing article, classified in class 604, subclass 378.

Invention III: Claims 16-20, drawn to a liquid absorbent panel, classified in class 428, subclass 170.

According to Examiner Reichle, Inventions II and I are related as combination and subcombination and are distinct, because the combination as claimed (Invention II) does not require the particulars of the subcombination as claimed (Invention I), and the subcombination (Invention I) has separate utility such as a shock absorbing pad to be placed inside a shoe.

2. Applicant responded to the Restriction Requirement on May 19, 2004, electing Invention I with traverse. Basically, Applicant argued that the restriction requirement between Inventions I and II is improper because

(i) Inventions II and I are not related as combination and subcombination,

(ii) The Examiner's allegation that the subcombination (Invention I) has *separate* utility is inaccurate, and

(iii) The Examiner's reason for insisting on restriction is not persuasive.

3. Examiner Reichle made the Restriction Requirement final in the Final Office Action sent August 23, 2004. Examiner Reichle found Applicant's arguments non-persuasive. Basically, Examiner Reichle argued that

(i) Inventions II and I are related as combination and subcombination because the terminology "body fluid absorbent wearing article" of the claim preambles may include a myriad of articles including combinations and subcombinations,

(ii) Invention II cannot always be used in the same manner because

Invention II does not require all the specifics of Invention I, e.g., compressive restoring elasticity, e.g., shock absorbing, and

(iii) There is a burden imposed on the Examiner to search the different groups of claims and to determine the applicability of each reference in such search with regards to each of the various groups of claims.

Applicant cannot agree with Examiner Reichle for the following reasons:

4. The restriction requirement between Inventions I and II is improper, because Inventions II and I are not related as combination and subcombination. As can be seen in attached Exhibit A which is a claim chart comparing independent claims 1 (Invention I – “subcombination”) and 6 (Invention II – “combination”), claim 6 (Invention II – “combination”) is broader than claim 1 (Invention I – “subcombination”) in all aspects. However, a combination claim must be narrower than a corresponding subcombination claim at least in some aspect, because the combination must include some element (e.g., a complementary subcombination) in addition to the subcombination. Thus, claim 6 (Invention II) is not a combination claim corresponding to subcombination claim 1 (Invention I). Claim 6 is simply a broader claim than claim 1. Both claim sets including claims 1-5 (Invention I) and 6-15 (Invention II) are directed to “body fluid absorbent wearing articles” and are not related as subcombination and combination.

5. The restriction requirement between Inventions I and II is improper, because the subcombination (Invention I) does not have separate utility. Examiner Reichle’s position that Invention II (claim 6 – “combination”) cannot always be used in the same manner as Invention I (claim 1 – “subcombination”) because Invention II (claim 6 – “combination”) does not require compressive restoring elasticity, e.g., shock absorbing, is erroneous. Applicant respectfully submits that Invention II can be used as a shock absorbing pad as well. The fact that, as a shock absorber, Invention II may not be as effective as Invention I, does not preclude Invention II from being used

in the exact same manner.

6. The restriction requirement between Inventions I and II is improper, because the search and examination of claims 1-5 (Invention I) and 6-15 (Invention II) can be made without serious burden on the Examiner.

First, Inventions I and II are classified in the same class (604) and very close subclasses (380 and 378, respectively), and can be covered in a single search.

Second, Examiner Reichle has demonstrated her capability to search across both subclasses in questions, as evident from forms PTO-892 mailed September 23, 2003 (Exhibit B) and August 23, 2004 (Exhibit C). Apparently, both Inventions I and II can be covered in a single search without serious burden on Examiner Reichle.

Third, Examiner Reichle has demonstrated her capability to apply a reference (e.g., *Hshieh*, U.S. Patent No. 5,545,155) which is classified in the subclass (378) of Invention II (claims 6-15) against claims 1-5 of Invention I. See paragraph 13 on page 8 of the August 23, 2004 Final Office Action, and paragraph 8 on page 5 of September 23, 2003 Office Action. Apparently, a determination of the applicability of references classified in the subclass of one invention (i.e., Invention II) against the claims drawn to another invention (i.e., Invention I) can be made without serious burden on Examiner Reichle.

Fourth, since claim 6 (Invention II – “combination”) is broader than claim 1 (Invention I), any rejection of claim 1 can be applied against claim 6. Differently speaking, references applied against claims 1-5 (Invention I) can also be used against claims 6-15 (Invention II). Apparently, the search and examination of claims 1-15 can be made without serious burden on Examiner Reichle.

7. For any of the reasons advanced at points 4-6, the Restriction Requirement between Inventions I and II is improper and should be withdrawn.

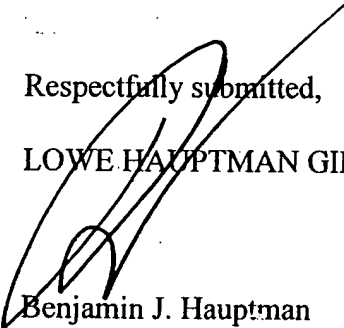
8. Since the Restriction Requirement between Inventions I and II is improper and should be withdrawn, claims 6-15 which has been improperly withdrawn from consideration by Examiner Reichle should be examined together with claims 1-5. The finality of the August 23, 2004 Office Action should be withdrawn, and a new Office Action treating claims 6-15 on the merits should be issued.

In view of the forgoing, Applicant, through their undersigned attorney, respectfully requests that the Commissioner compel Examiner Reichle to withdraw (1) the restriction requirement between Inventions I and II and (2) the final nature of the August 23, 2004 Official Action.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Exhibit A

	Invention I	Invention II
A	1. A body fluid absorbent wearing article, comprising: a liquid-pervious topsheet;	6. A body fluid absorbent wearing article, comprising: a liquid-pervious topsheet;
B	a liquid-impervious backsheets;	a liquid-impervious backsheets; and
C	a liquid-absorbent panel disposed between said topsheet and said backsheets;	a liquid-absorbent panel disposed between said topsheet and said backsheets;
D	said panel comprising a first fibrous assembly sub-panel lying on a side of said topsheet and	said panel comprising a first fibrous assembly sub-panel underlying said topsheet
E	having a compressive restoring elasticity,	
F	and a substantially flat second fibrous assembly sub-panel underlying said first fibrous assembly sub-panel;	and a second fibrous assembly sub-panel underlying said first fibrous assembly sub-panel;
G	said first fibrous assembly sub-panel having a substantially flat portion spaced from said second fibrous assembly sub-panel by a first given dimension	
H	and a plurality of protuberant portions extending from said flat portion toward said second fibrous assembly panel so as to bear against said second fibrous assembly sub-panel; and	said first fibrous assembly sub-panel having a plurality of protuberant portions extending away from said topsheet and toward said second fibrous assembly panel so as to bear against said second fibrous assembly sub-panel;
I	said first fibrous assembly sub-panel having a fiber density increasing toward said second fibrous assembly sub-panel	
J	which has a fiber density higher than that of said first fibrous assembly sub-panel.	said second fibrous assembly sub-panel having a fiber density higher than that of said first fibrous assembly sub-panel.

Notice of References Cited

NOV 23 2004

TRADEMARK OFFICE

Application/Control No.

10/024,544

Applicant(s)/Patent Under

Reexamination

NAKASHITA, MASASHI

Examiner

Karin M. Reichle

Art Unit

3761

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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3,046,986	07-1962	Harwood	604/375
	B	US-3,494,362	02-1970	Burgeni	604/374
	C	US-5,545,155	08-1996	Hseih et al.	604/378
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
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	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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Notice of References Cited	Application/Control No. 10/024,544		Applicant(s)/Patent Under Reexamination NAKASHITA, MASASHI	
	Examiner Karin M. Reichle		Art Unit 3761	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-4,435,178	03-1984	Fitzgerald, Harry G.	604/365
	B	US-2,952,260	09-1960	BURGENI ALFRED A	604/374
	C	US-5,423,786	06-1995	Fung et al.	604/367
	D	US-5,990,377	11-1999	Chen et al.	604/381
	E	US-6,037,518	03-2000	Guidotti et al.	604/378
	F	US-6,642,432	11-2003	Matsui et al.	604/380
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
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